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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,385	09/16/2003	Takashi Ohira	Q77491	2169
7590 10/06/2005 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3213			EXAMINER BERMAN, SUSAN W	
			ART UNIT 1711	PAPER NUMBER

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

✓ 3

Office Action Summary

Application No.

10/662,385

Applicant(s)

OHIRA, TAKASHI

Examiner

Susan W. Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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Terminal Disclaimer

The terminal disclaimer filed on 06/16/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 10/662,330 (Pub. No 2004/0052970) has been reviewed and is accepted. The terminal disclaimer has been recorded. In response, the provisional rejections under the judicially created doctrine of obviousness-type double patenting are withdrawn.

Response to Amendment

The rejection of claims 3 under 35 U.S.C. 112, second paragraph, is withdrawn in response to the amendment filed 07/18/2005.

Response to Arguments

Applicant's arguments filed 07/18/2005 have been fully considered but they are not persuasive. In the table on page 9 of the arguments applicant asserts that the claimed invention does not comprise a photopolymerizable monomer. This argument is not persuasive because the claim language "aqueous resin having photo-curable functional groups in a molecule" clearly encompasses an aqueous resin including a "molecule" containing photocurable functional groups, thus reading on an aqueous resin comprising a photopolymerizable monomer. The water-dispersible latex taught by Taylor et al comprising a water-dispersible polymer and a photopolymerizable monomer is encompassed by the language "aqueous resin having photo-curable functional groups in a molecule" recited in the instant claims. The recitation "carbodiimide base crosslinker or ethyleneamine base crosslinker" clearly encompasses the carbodimide present in polymeric particles taught by Taylor et al, wherein the polymer particles are considered to be the "base". The compositions disclosed by Taylor et al include a photoinitiator, thus anticipating the photoinitiator in the instant claims. The intended function of the photoinitiator is not

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sufficient to distinguish the instantly claimed composition from the prior art composition. Applicant argues that Taylor et al teach protective overcoat compositions while applicant claims a composition for golf balls. This argument is not persuasive because the future intended use of a composition does not provide patentable weight to a composition disclosed in the prior art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-8 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "carbodiimide base crosslinked or a ethyleneimine base crosslinker" renders the claims indefinite. It is not clear what kind of "base" is intended to be present. The carbodimindes and ethyleneimines recited in claims 9-10 and disclosed in the specification do not contain any apparent "base".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1 and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Taylor et al (6,352,805). Taylor et al disclose photocrosslinkable water-dispersible latex compositions comprising a photoinitiator and multifunctional monomer for forming a protective overcoat. See column 3, line 48, to

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column 5, line 46. Polymer matte particles containing reactive functional groups, such as carbodiimide and aziridine, capable of crosslinking with the binder polymer are taught in column 7, lines 24-36. With respect to claims 4 and 5, Taylor et al clearly teach (meth)acrylate-functional monomers (column 4, lines 21-38). With respect to claims 6-8, Taylor et al clearly teach urethane, polyester and acrylic resin having carboxyl groups (column 4, line 47, to column 5, line 46).

Allowable Subject Matter

Claims 3 and 11-12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Crast et al (6,146,288) disclose IV curable clear coat compositions for golf balls, but do not disclose aqueous resins. Hamada et al (6,255,382) disclose coating compositions for golf balls comprising a water-dispersed polyurethane and a carbodiimide crosslinker. Hamada et al do not suggest adding a photocurable component or a photoinitiator.

Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH**

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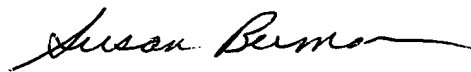
shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SB
10/3/05


Susan W Berman
Primary Examiner
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